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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/431,902	11/02/1999	KAZUYUKI OHTSU	FUJY=16.705	9388
26304	7590	08/23/2004	EXAMINER	
KATTEN MUCHIN ZAVIS ROSENMAN			FERRIS, DERRICK W	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	

2663

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/431,902

Applicant(s)

OHTSU ET AL.

Examiner

Derrick W. Ferris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-8 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 02 November 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Finality*

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### *Response to Amendment*

2. **Claims 1-8** as amended are still in consideration for this application. Applicant has amended claims 1, 2, 3, 4, 7, and 8 in response filed 05/16/03.
3. Examiner does **not withdraw** the obviousness rejection to *Vargo et al.* ("*Vargo*") in view of *Haeggstrom* for claims 1, 2, 7 and 8. However, upon further reconsideration, the Examiner has **withdrawn** the rejection to *Vargo et al.* ("*Vargo*") in view of *Haeggstrom* for claims 3-6.

In response to applicant's remarks filed 8/4/04, the examiner notes two items of issue. The first issue is a gateway knowing the capabilities of a receiving end in order to perform a step of judging as argued by applicant. Examiner notes the first issue is not recited in the claims with respect to a step of judging for claims 1, 2, 7 and 8 and thus maintains the rejection. However, upon further reconsideration, the examiner agrees with applicant that independent claim 3 does teach this further limitation with respect to a selection section for receiving information about the CODEC forms *from a second gateway apparatus*. This limitation, however, is not taught in the other independent claims. As *Vargo* is silent to receiving information from a second gateway about the second gateway's capabilities, the examiner has withdrawn the rejection for claim 3. At second issue is the actual step of judging as recited in the claims. The examiner will agree with applicant that the response provided by the examiner in the advisory action may not have

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been the clearest explanation with respect to the examiner's figure 1. In particular, the examiner notes that *the terminals* have a set codec and not the gateways which still reads on the claims with respect to *a single gateway device* as recited in the claims (i.e., claim 3 further recites two gateways). As such, the clarified examiner's figure 1 is provided below.

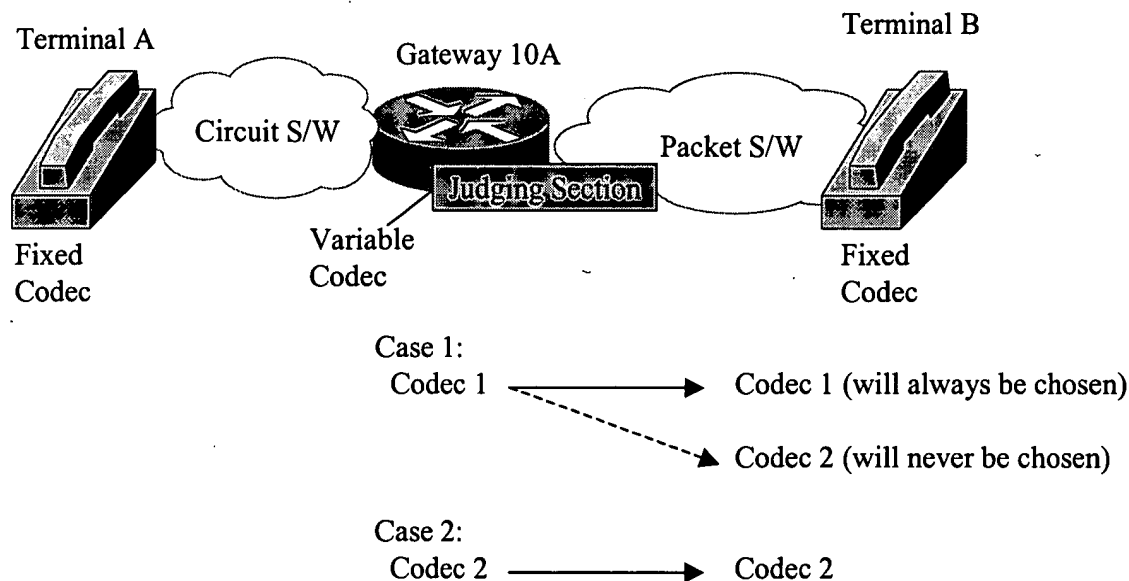


Figure 1: Examiner's Figure 1

As to examiner's figure 1, *Vargo* teaches a gateway such as gateway 10a shown in figure 1. *Vargo* does not show the end terminals in figure 1 but teaches the terminals in the disclosure. In particular, *Vargo* teaches that the codecs for the terminals are not dynamically selected, see e.g., column 10, lines 11-25 (i.e., instead the gateways dynamically select codecs). Thus in the purposed scenario above gateway 10a, in setting up a connection from terminal A to terminal B, must translate the different compressions in order for terminal A and terminal B to communicate with one another. In other words, column 7, lines 18-35 of *Vargo* teaches that a gateway (e.g., gateway 10a) dynamically selects a codec based on a codec algorithm. The examiner will agree that *Vargo* may not be clear in this section that a codec is selected based on the type of codec at

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the receiving end with respect to the claim limitation for a judging section. However, *Vargo* teaches in the background that in order for the terminals to communicate with one another the codec programs at both ends must be able to understand each other, see e.g., column 2, lines 8-13. Thus it is inferred that gateway 10a must select a codec that will allow both ends to communicate with one another teaching a judging section.

Although the rejection for claim 3 is withdrawn, the examiner still feels the subject matter is still not allowable and thus has provided a new rejection for the claim as necessitated by amendment using a reference provided by the examiner previously.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 2, 7 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,356,545 to *Vargo et al.* ("*Vargo*") in view of U.S. Patent No. 6,167,040 to *Haeggstrom*.

As to **claims 1, 2, 7 and 8**, *Vargo* discloses an Internet system able to dynamically select a CODEC (i.e., perform expansion and compression using a broad but reasonable interpretation of the term CODEC) [Abstract]. Specifically, *Vargo* discloses an invention relating generally to both the Internet and the PSTN (i.e., circuit switched networks) thus creating a motivation as a whole for applying this reference [column 1, lines 15-20]. *Vargo* presents a gateway 10 for voice communications between an Internet

Protocol (IP) network 17 and a circuit switched network 11 [figure 1; column 3, lines 42-56; column 4, lines 36-40]. This gateway uses software to create a session (figure 4) and control the characteristics of a session at a voice port by not only adjusting such factors as the packet size or bundling of a packet [column 7, lines 6-17] but also varying in the selection of a codec per packet as well [column 7, lines 18-27]. Thus examiner notes a broad but reasonable teaching of either expansion or compression depending on the type of codec employed per packet. Thus examiner notes that should no codec be employed per packet then a tandem free operation (TFO) is broadly performed in that the software (i.e. controller) of the gateway can transmit the packets without subject to expansion/compression using a broad but reasonable interpretation of the recited claimed subject matter.

Examiner notes the reference also indirectly teaches a setting section using a broad but reasonable interpretation of the claim. Examiner notes specifically that *Vargo* teaches selecting a codec 222 based on speech quality 221 at a voice port 61 (figure 11(b)) where it would have been obvious to a skilled artisan prior to applicant's invention that the codec selected (i.e., the judging section with controller) is based on a pass-through state if compression has already taken place on the transmitting side. The motivation for a pass-through state comes from an end-to-end tandem free operation as is known in the art (in particular see column 2, lines 8-27 of *Vargo*). *Haeggstrom* provides additional support for end-to-end tandem free operation using the same codec end-to-end such that the codec in the gateway must be the same which is taught in the second embodiment shown in figure 4.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-8** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,324,409 B1 to *Shaffer et al.* ("*Shaffer*").

As to **claims 1, 2, 3, 7 and 8**, *Shaffer* teaches a judging section at an intermediate device (i.e., gateway). In particular, *Shaffer* teaches both a circuit-switched network and a packet-switched network in which the intermediate devices are aware of all the other devices on the network, see e.g., columns 7-8. As such, in step 512 of figure 5a a gateway is capable of determining an end-to-end coding scheme based on codecs supported in other gateway devices and thus teaches a judging section. In addition, examiner notes that the gateway also tests to see if the codec is the preferred codec and whether transcoding would occur with respect to a judging section, see e.g., figure 6b. Specifically, a first gateway is shown as TIS 304a and a second gateway is shown as TIS 304b (or 304d) where an IP network 306a,b is between the first and second gateway with respect to figure 3. A notification signal/section is sent in step 504 and step 510. A selection section and judging section are taught as part of step 512 for a gateway device such as TIS 304a. Since the gateway supports more than one type of codec, expansion

and compression steps are also taught. A second notification is taught as part of step 513. With respect to the steps of a judging section see e.g., figures 6a and 6b. In particular, the gateway first searches for a preferred codec and a codec that results in no transcoding, see e.g., step 654 thus teaching a judging section.

As to **claims 4-6**, see e.g., figures 6a and 6b where there are preferred compression methods which are first tested. In addition, the compression methods may also be prioritized (i.e., preferred). Thus *Shaffer* teaches keeping the compressed data in the same form if the compressed data is sent from the first circuit switched network (as possibly a preferred compression) and a second notification section for the CODEC selected by the intermediate device or gateway.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (703) 305-4225.


The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
DWF

Derrick W. Ferris  
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Art Unit 2663

  
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